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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/701,272

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R. Scott Twomey

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08/09/2006

HARNESS, DICKEY & PIERCE, P.L.C.

P.O. BOX 828

BLOOMFIELD HILLS, MI 48303

EXAMINER

APANIUS, MICHAEL

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/701,272

Applicant(s)

TWOMEY ET AL.

Examiner

Michael Apanius

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 15, 16 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-10, 17-22 and 24 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20050622</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to the amendment filed 5/22/2006. The amendments to claims 1-3, 12-22, 24 and 25 and the cancellation of claim 23 are acknowledged. Currently, claims 1-22, 24 and 25 are pending.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: at page 6, line 11, it appears that "to" should be --two--. Appropriate correction is required.

#### ***Claim Objections***

3. Claims 2, 10, 12-14 and 20-22 are objected to because of the following informalities.
  - a. At claim 2, line 2, it appears that "engaging" should be --engageable with--.
  - b. At claim 10, line 2, it appears that "in contact with" should be --adapted to contact--.
  - c. At claim 12, line 2, it appears that "contacts" should be --is adapted to contact--.
  - d. At claim 20, line 2, it appears that "engages" should be --is engageable with--.

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- e. At claim 21, line 4, it appears that the second recitation of "block" should be --body--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17, 20, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz (US 6,077,270).
6. Katz discloses a sizing apparatus for determining the anterior-posterior size of a distal end of a femur, the apparatus comprising: a block (figure 8) having a face (one of 47 in figure 8) engageable with a resected surface of the distal end of the femur, the block having an upper portion (48) supporting a rod (42) and a lower portion having a base (the channel formed between elements 46 and 47 as shown in figure 8); a body (35, 36) slideably mounted on the base and the rod for movement relative to the block in a medial-lateral direction; and a stylus (64) mounted on the body. Note that the body is slideably mounted on the rod, which in turn means that the body is slideably mounted on the base because the rod is attached to the base.
7. Katz discloses a method for determining a size of a distal femur, the method comprising: providing a sizing apparatus as noted above; engaging a face (one of 47 in

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figure 8) of the block to the distal femur; selectively sliding (column 11, line 65 - column 12, line 11) the body along a rod (42) affixed to the block in a medial-lateral direction; moving (column 12, lines 12-14) the stylus to bring a tip of the stylus in contact with an anterior surface of the distal femur; observing an indicator (81) associated with the movement of the stylus; and reading the size of the distal femur on a scale (80) affixed to the body at a position of the indicator. Note that the rotation of the body as disclosed requires sliding the body in a medial-lateral direction.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4, 9, 10, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,077,270) in view of Axelson, Jr. et al. (US 6,558,391).

10. Katz discloses a U-shaped member (at 46 and 48 in figure 8) supporting the rod; a lower portion of the body is slidably received in a U-shaped channel (see around 45 in figure 5) of the base; and modularly connecting a support (300 in figure 34) to the base.

11. Katz further discloses that the body has a portion (see figure 5) that surrounds most of the rod. However, Katz does not expressly disclose that the rod passes through an aperture of the body.

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12. It is well-known in the art to provide an aperture on an element through which a rod passes for the purpose of allowing the element to slide on the rod as shown by Axelson (see the aperture in element 22b in figure 5).

13. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have substituted an aperture to mount the body on the rod as is well-known in the art and as taught by Axelson for the portion that surrounds most of the rod of Katz because an aperture and a portion that surrounds most of the rod are art-recognized equivalents that equally enable slidable attachment of a body to a rod.

14. Katz also does not expressly disclose that a lower portion of the body engages a base of the block. However, Katz does disclose that the lower portion of the body is slidably received in a U-shaped channel.

15. Axelson teaches a body (shown in figure 4) that engages a U-shaped channel (between the tops of 14a and 14b as seen in figure 3).

16. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have modified the body of Katz to engage the U-shaped channel as taught by Axelson because providing additional support to help keep the body properly oriented is routine and well-known within the art.

17. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,077,270) as modified by of Axelson, Jr. et al. (US 6,558,391), as applied to claims 1-4, 9, 10, 18 and 19 above, and further in view of D'Antonio (US 5,810,831).

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18. Katz as modified by Axelson does not expressly disclose a stylus shaft that can rotate and slide in an anterior-posterior direction. Katz as modified by Axelson also does not expressly disclose a window opening for observing an indicator on a shaft.

19. D'Antonio teaches a stylus (40) that includes a shaft (44) received in a bore (46) of a body, such that the shaft can slide in an anterior-posterior direction and rotate relatively to the bore. The stylus includes an arm (42) and a stylus tip (48). D'Antonio further teaches a window opening (54), an indicator (52) on the shaft, and a scale (58) on the body.

20. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have substituted the stylus and indicator window configuration as taught by D'Antonio for the stylus and indicator configuration of Katz as modified by Axelson because the two configurations equally enable measurement of the femur and the configuration used is not critical to the overall apparatus.

21. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,077,270) in view of D'Antonio (US 5,810,831).

22. Katz also does not expressly disclose a window opening for observing an indicator.

23. D'Antonio teaches a stylus and indicator configuration as noted above.

24. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have substituted the stylus and window indicator configuration as taught by D'Antonio for the stylus and indicator configuration of Katz because the two

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configurations equally enable measurement of the femur and the configuration is not critical to the overall apparatus.

***Allowable Subject Matter***

25. Claims 11-16 and 25 were previously indicated as allowable.

***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8am-4:30pm.


27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA

  
MAX F. HINDENBURG  
\* SENIOR PATENT EXAMINER  
TECHNOLOGY CENTER 3700